



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Phillips *et al.*

Serial No. 09/735,363

Filed: December 12, 2000

For: THERAPEUTICALLY USEFUL
SYNTHETIC OLIGONUCLEOTIDES

#13/K.T.
10/7

Art Unit: 1635

Examiner: Jane Zara

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SEP 03 2002

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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Assistant Commissioner For Patents
Washington, D.C. 20231

Sir:

Responsive to the Office Action mailed July 26, 2002, a response to which is due September 26, 2002, by virtue of the accompanying petition for a one-month extension and check for \$55.00 for the extension fee, Applicants respectfully request consideration of the appended remarks.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231, on September 25, 2002.

Sharonda R. Williams

Sharonda R. Williams, Reg. No. 52,365

RESTRICTION/ELECTION REQUIREMENT

The Office Action of July 26, 2002 vacated the restriction requirement of June 6, 2002 due to ambiguities in the restriction requirement. In response to the Restriction/Election Requirement mailed July 26, 2002 in the above-identified patent application, Applicants provisionally elect SEQ. ID NO. 25 (GGGTGG). This election is made with traverse.

The Election requirement is respectfully traversed. The Examiner cites 35 U.S.C. 121 and 37 C.F.R. § 1.141 and states that "claims 1, 7, 8, 11, 27, 28, 42, and 44 contain sequences which are considered to be unrelated inventions and thus are patentably distinct." The Examiner further states: "[T]he different sequences are structurally, functionally, and biologically unrelated to each other. Furthermore, a search of more than one of the sequences claimed in claims 1, 7, 8, 11, 27, 28, 42, and 44 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one of the claimed sequences. In view of the foregoing, one sequence is considered to be a reasonable number of sequences for examination."

The Examiner cites MPEP 2434 and states that the Commissioner partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of nucleotide sequences to be claimed in a single application. Applicants respectfully bring to Examiner's attention that MPEP 2434 states:

"[I]n most cases, up to **10** independent and distinct nucleotide sequences will be examined in a single application without restriction.

Those sequences which are patentably indistinct from the sequences selected by the applicant will also be examined." (emphasis added).

Sequences of Claims 1, 7, 8, 11, 27, 28, 42, and 44 are short non-coding oligonucleotide sequences (less than 30 base pairs) and are not of complex nature. Because these sequences are not complex, the Applicants respectfully assert that a search of ten sequences would not present an undue burden to the Patent and Trademark Office. Therefore, the Applicants respectfully request withdrawal of the Election Requirement, and examination of at least ten sequences recited in Claims 1, 7, 8, 11, 27, 28, 42, and 44. Should the Examiner allow the examination of at least ten sequences, the Applicants provisionally elect the following ten sequences: SEQ ID NO. 25 (GGGTGG), SEQ ID NO. 45 (GGGAGG), SEQ ID NO. 46 (GGGC GG), SEQ ID NO. 9 (TGTGTG), SEQ ID NO. 10 (GTGTGT), SEQ ID NO. 8 (GTG), SEQ ID NO. 26 (TTGTTT), SEQ ID NO. 41 (GGTTGG), SEQ ID NO. 42 (GGAAGG), and SEQ ID NO. 43 (GCCCGG). The Examiner had previously requested election of ten sequences in the restriction requirement of June 6, 2002 following a response filed with similar arguments on March 4, 2002. Accordingly, Applicants request that the Examiner again permit election of at least ten sequences.

This Response to the Restriction/Election Requirement is fully responsive. Applicants respectfully request that the Examiner contact the undersigned attorney if any questions arise concerning this Response to the Restriction Requirement.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 404-532-6914 is requested.

No additional fees are believed due, however, the Commissioner is hereby authorized to charge any deficiencies which may be required or credit any overpayment to Deposit Account Number 11-0855.

Respectfully submitted,



By: Sharonda R. Williams
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Docket No.: 02811-0181 (42368-250224)

1635
PATENTS

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re Application of:

Docket No. 02811-0181 (42368-250224)

Phillips et al.

Serial No. 09/735,363

Filed: December 12, 2000

For: Therapeutically Useful Synthetic Oligonucleotides

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

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Transmitted herewith is a paper in the above-identified application.

- Response to Restriction/Election Requirement (4 pgs.)
- Petition For One-Month Extension of Time. (1 pg.)
- No additional fee is required.
- The additional fee is calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	RATE	ADDIT. FEE
TOTAL	42	MINUS	42=	0	x9	\$0	x18	\$0
INDEP.	6	MINUS	6=	0	x40	\$0	x80	\$0
FIRST PRESENTATION OF					+135	\$	+270	\$
<input checked="" type="checkbox"/> MULTIPLE DEPENDENT CLAIMS								
					TOTAL ADDITIONAL FEE	\$0		\$0

- A check in the amount of \$55.00 is attached to pay the fee for filing the Petition For One-Month Extension of Time.
- The Commissioner is hereby authorized to charge any additional fees required under 37 CFR §1.16, or credit any overpayment, to Account No. 11-0855. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on September 25, 2002.

Signature

ATLLIB02# 73483.2

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